

REMARKS

Reconsideration of this application, as amended, is respectfully requested.

In the Official Action, the Examiner objects to the Abstract because it contains legal phraseology. In response, the Abstract has been amended to delete such legal phraseology, such as changing "comprising" on line 4 to --including-- and "means" on line 7 to --schemes--. Accordingly, it is respectfully requested that the objection to the Abstract be withdrawn. A clean copy of the amended Abstract is provided on a separate sheet for the convenience of the Examiner.

In the Official Action, the Examiner further objects to the incorporation by reference of the priority document and asks that the specification be amended to include all essential material. In response, the Applicant respectfully submits that the essential material of the priority document is already contained in the specification. Accordingly, it is respectfully requested that the objection to the specification be withdrawn.

In the Official Action, the Examiner rejects claims 1-15 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 1, the Examiner objects to the use of "high" and "thin" because they are indefinite. In response, claim 1 has been amended to delete the term "thin" from claim 1. However, the Applicant respectfully submits that the use of the term "high" is appropriate because it has an accepted meaning in the art of medical device sterilization as is defined in the specification at page 13. Furthermore, the Applicant respectfully submits that the term "high" is used to define the sterilization, which is not a part of the claimed vessel.

Also with regard to claim 1, the Examiner objects to the phrase "the endoscope" because it has no antecedent basis in the claim. The Examiner further argues that the use of the term "an endoscope" in the preamble does not provide such an antecedent. Applicants respectfully disagree with the Examiner and submit that the term "an endoscope" as recited in the preamble does provide a proper antecedent for the phrase "the endoscope" as subsequently used in the claim. If "the endoscope" was changed to "an endoscope," the phrase "an endoscope" would appear twice in the claim and would cause confusion as to which endoscope is being referred to (the one in the preamble or the subsequently recited endoscope).

Lastly with regard to claim 1, the Examiner argues that the phrase "local pressing forces" is vague and indefinite. In response, claim 1 has been further amended to delete "local" from such phrase.

With regard to claim 3, the Examiner argues that the phrase "the peripheral elements" lacks antecedent basis. In response, claim 3 has been amended to change the same to --peripheral elements--.

With regard to claims 4 and 5, the same have been amended to improve their form and readability.

With regard to claim 6, the Examiner argues that the phrase "the operating part" lacks antecedent basis. In response, claim 6 has been amended to change the same to --an operating part--. Claim 6 has been further amended to add the phrase --in the recess section-- before the end of claim 6 to improve its readability.

With regard to claim 8, the Examiner argues that the activity of the restricting member recited therein was not set forth in claim 7. In response, claim 8 has been amended to refer to the activity of the flexible restricting member in claim 8.

With regard to claim 9, the Examiner argues that it is improper to refer to the "vessel" in the claim. In response, claim 9 has been amended to delete such a reference to the "vessel." Also with regard to claim 9, the Examiner objects to the use of "high" for the same reasons as claim 1. The Applicant respectfully disagrees with such objection for the same reasons as set forth above.

With regard to claim 13, the Examiner argues that the term "smooth" is vague and indefinite. In response, claim 13 has been amended to change the same to "substantially planar."

With regard to claim 14, the Examiner argues that the same is vague and indefinite because the Examiner cannot determine what structure is being recited. In response, claim 14 has been canceled.

With regard to claim 15, the Examiner objects to the use of the term "gentle" as being vague and indefinite and because it improperly attempts to further limit a structural element that has not been previously claimed (e.g., an endoscope). In response, claim 15 has been canceled.

Accordingly, it is respectfully requested that the rejection of claims 1-15 under 35 U.S.C. § 112, second paragraph, be withdrawn. Although not rejected, the Applicant has also amended claims 2, 7, 11, and 12 to improve their form and readability. The Applicant respectfully submits that the present amendment is fully supported in the original disclosure.

Thus, no new matter has been introduced into the disclosure by way of the present amendment.

In the Official Action, the Examiner rejects claims 1, 2, 7, and 13 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,843,387 to Dane et al., (hereinafter “Dane”). Additionally, the Examiner rejects claims 1-15 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,534,221 to Hillebrenner et al., (hereinafter “Hillebrenner”). In response, the Applicant respectfully traverses the Examiner’s rejections under 35 U.S.C. § 102(b) for at least the reasons set forth below.

With regard to Dane, the Examiner argues that the same teaches an apparatus for containing an endoscope for steam sterilization and having a resilient force preventing means, which surrounds a portion of the endoscope to support and protect it. The Applicant respectfully disagrees with the Examiner’s reading of the Dane reference. Although not expressed in Dane, the apparatus disclosed therein is used for sterilization of rigid endoscopes and instruments, which are not prone to deformation due to pressing forces during high-pressure, high-temperature steam sterilization. Furthermore, although not described in Dane, the instrument must be press fit into the opening (34) by deforming the portions (36) surrounding the opening (34). If used with endoscopes having a soft insertion section, the press fit will cause a deformation in the outer wall of the insertion portion, which may become permanent after the application of high-pressure, high-temperature steam sterilization. This is precisely what the present invention is directed to overcome. Therefore, the holding portions (30, 32) of Dane exert a pressing force on the endoscope inserted in the opening (34).

With regard to Hillebrenner, the Examiner argues that the same teaches a container for endoscope sterilization having a tray and a lid and a means for preventing

different areas of the endoscope from touching during sterilization. Although, the Examiner's reading of the Hillebrenner reference is correct, the same does not amount to a pressing force prevention means. As shown in Figures 19-21 of Hillebrenner, clips 252, 254 are used to space the insertion section of the endoscope apart. However, such clips themselves are constructed similar to the holding portions (30, 32) of Dane and require a pressing force to fit the endoscope therein. Therefore, the surface of the clip will exert a pressing force against the endoscope wall and may deform the same when subjected to high-pressure, high-temperature steam sterilization. Furthermore, the Hillebrenner reference spaces the endoscope surface in order to minimize contact area to facilitate sterilization and therefore does not contemplate the effect of the pressing forces caused by the clips on the outer surface of the endoscope insertion portion during high-pressure, high-temperature steam sterilization.

The Applicant also notes that in the arrangement of Dane, the medical device is supported, at least in part, by the strips 30 and 32 provided in the top tray 50 and the bottom tray 12, thereby deforming a flexible portion thereof. The same can be said for the arrangement of Hillebrenner.

With regard to the rejections of claims 1-15, under 35 U.S.C. § 102(b), a vessel for high-temperature high-pressure steam sterilization having the features described above and as recited in independent claim 1, are nowhere disclosed in either Dane or Hillebrenner. Since it has been decided that "anticipation requires the presence in a single prior art reference, disclosure of each and every element of the claimed invention, arranged as in the claim,"¹ independent claim 1 is not anticipated by either Dane or Hillebrenner. Accordingly, independent claim 1 patentably distinguishes over both Dane and Hillebrenner and is

¹ Lindeman Maschinenfabrik GMBH v. American Hoist and Derrick Company, 730 F.2d 1452, 1458; 221 U.S.P.Q. 481, 485 (Fed. Cir., 1984).

allowable. Claims 2-13 being dependent upon claim 1 are thus at least allowable therewith (claims 14 and 15 being canceled). Consequently, the Examiner is respectfully requested to withdraw the rejections of claims 1-15 under 35 U.S.C. § 102(b).

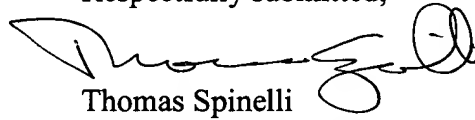
Lastly, the Examiner rejects claims 1-15 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-10 of U.S. Patent Application No. 09/919,190. The Examiner argues that the claims of the present application are the same as those of U.S. Patent Application No. 09/919,190 with the exception of a sealing lid in the present application. The Applicant respectfully disagrees.

The claims of the present application recite a vessel having a pressing force preventing means while the claims of U.S. Patent Application No. 09/919,190 recite a positioning member for restricting bending of a portion of the insertion member of an endoscope. Therefore, the claims of the present application and those of U.S. Patent Application No. 09/919,190 differ significantly in structure. The claims of the present application and those of U.S. Patent Application No. 09/919,190 also differ in objective and solve different problems in the prior art. An objective of the claims of the present application is to minimize deformation of portions of an endoscope caused by pressing forces exerted on the endoscope during high-pressure, high-temperature steam sterilization, while an objective of the claims of U.S. Patent Application No. 09/919,190 is to prevent the insertion portion of an endoscope from being bent at a small radius during high-pressure, high-temperature steam sterilization.

Thus, the Applicant respectfully traverses the Examiner's rejection of claims 1-15 under judicially created doctrine of obviousness-type double patenting and respectfully requests that the same be withdrawn in light of the above remarks.

In view of the above, it is respectfully submitted that this application is in condition for allowance. Accordingly, it is respectfully requested that this application be allowed and a Notice of Allowance issued. If the Examiner believes that a telephone conference with Applicant's attorneys would be advantageous to the disposition of this case, the Examiner is requested to telephone the undersigned.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Thomas Spinelli', with a circular flourish at the end.

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TS:cm
Enclosure (Substitute Abstract of the Disclosure)